

REMARKS

In response to the office action mailed March 24, 2008, Applicant submits this Amendment accompanied by a petition for two-month extension of time. The appropriate petition fee has been paid by credit card.

In light of the following remarks, Applicant respectfully submits that the present application is in condition for allowance.

CLAIM REJECTIONS – 35 U.S.C. §112

Claims 1-9 stand rejected for using the term “hot,” which the examiner asserts is a relative term that renders these claims indefinite. Applicant respectfully disagrees. The phrase “hot water” and “hot water source” refer to aspects of the invention associated with making coffee, espresso, tea, a shot of steam for forming foam, etc. *See*, paragraph [0011], for example. As such, a person having ordinary skill in the art would clearly understand that the term “hot” is used to encompass the entire range of temperatures at which any of these types of products may be brewed or prepared. For example, in one embodiment, a target temperature for the hot water might be 96°C, as described in paragraph [0021].

Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

CLAIM REJECTIONS – 35 U.S.C. §103

Claims 1-9 stand rejected under 35 U.S.C. §103(a) as allegedly obvious over Knepler (US 5,375,508), “as evidenced by” Mercier (US 2002/0121197). Applicant respectfully traverses these rejections.

The present application is generally directed to a method for controlling a drink preparation machine for preparing a multiple number of different drink units. As recited in claim 1, the method includes withdrawing hot water for the multiple number of different drink units from a common hot water source. A performance status of the hot water source is monitored, and the withdrawal is controlled based on the monitored performance status. Specifically, (1) hot water withdrawal is enabled for all of the different drink units at a predetermined full performance status; (2) hot water withdrawal is blocked for all of the different drink units at a predetermined zero performance status; and (3) hot water withdrawal is blocked for at least one predetermined drink unit and enabled for at least one

predetermined drink unit at a predetermined partial performance status. So configured, the method and machine of the present application provide for the dynamic withdrawal of hot water during drink preparation, which advantageously uses the supply of hot water up until the last drop, as described in paragraph [0005], for example.

Neither Knepler, Mercier, nor any other cited reference discloses or suggests such features.

In the Office Action, the examiner concedes that Knepler does not disclose blocking hot water withdrawal for at least one predetermined drink unit and enabling hot water withdrawal for at least one predetermined drink unit at a predetermined partial performance status, as recited in claim 1. The examiner concludes, however, that it would have been obvious to a person having ordinary skill in the art to modify Knepler to arrive at the claimed method.

From the Office Action, it seems that the examiner reaches this conclusion through two different rationales. First, it seems that the examiner asserts that it would have been obvious to modify Knepler in view of Knepler, alone, which discloses temperature and level sensors, a CPU that is **capable** of performing the claimed method, and beverages of *different sizes*. Alternatively, the examiner seems to assert that it would have been obvious to modify Knepler in view of Mercier, because Knepler discloses temperature and level sensors, and a CPU that is **capable** of performing the claimed method, and Mercier discloses preparing beverages of *different temperatures*. Both of these rationales are completely implausible.

First, the mere fact that a known device, e.g., a CPU, is **capable** of performing a claimed method does not provide a proper basis for rendering that method obvious. Of course, a CPU is capable of being programmed to perform a variety of different methods such as operating a car, an aircraft, a beverage dispenser, etc. Any such method, however, requires specific programming logic. Nothing discloses or suggests programming the CPU of Knepler to perform the method recited in claim 1 of the present application.

Second, a *prima facie* case of obviousness requires that the prior art reference, references, and/or knowledge generally available to one of ordinary skill in the art, when combined, disclose or suggest all of the claim limitations. As mentioned, the examiner concedes that Knepler does not disclose blocking hot water withdrawal for at least one

predetermined drink unit and enabling hot water withdrawal for at least one predetermined drink unit at a predetermined partial performance status, as recited in claim 1. Moreover, the examiner has not asserted that Mercier discloses or suggests these features. The examiner only relies on Mercier as disclosing the desire to prepare beverages having different temperatures. Therefore, the examiner must be relying on common knowledge, or official notice, to formulate the obviousness rejections.

If the examiner is relying on common knowledge or official notice, Applicant respectfully submits that such reliance is improper. Rejections based on common knowledge or official notice should only be used to notice facts where the facts asserted to be well-known, or to be common knowledge in the art, are capable of instant and unquestionable demonstration as being well-known. *See*, MPEP 2144.03. This is not true of the instant situation. In contrast, while Knepler discloses beverages of different sizes and Mercier discloses beverages of different temperatures, neither the references themselves or any evidence set forth by the examiner disclose or suggest operating in accordance with partial performance criteria as recited in claim 1 of the present application.

Moreover, the examiner has not provided any factual findings predicated on sound technical and scientific reasoning to support the finding of common knowledge or official notice, as required by MPEP 2144.03. Arriving at the claimed invention by the mere existence of a CPU and the desire to provide beverages of different sizes (Knepler) or different temperatures (Mercier) requires a logical leap that the examiner could only have made through hindsight reasoning gleaned from Applicant's own disclosure, which is prohibited by MPEP 2145. Accordingly, Applicant respectfully traverses the examiner's reliance on common knowledge and/or official notice.

In light of the foregoing, reconsideration and withdrawal of the outstanding obviousness rejections is respectfully requested.

CONCLUSION

Each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. If there is any remaining issue that the office believes may be remedied

via telephone conference, Applicant invites the Examiner to contact the undersigned at (312) 474-6300.

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Respectfully submitted,

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